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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,703	10/24/2003	Joseph M. Koenig JR.	TRI4546P0161US	9791

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WOOD, PHILLIPS, KATZ, CLARK & MORTIMER  
500 W. MADISON STREET  
SUITE 3800  
CHICAGO, IL 60661

EXAMINER
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RACHUBA, MAURINA T

ART UNIT	PAPER NUMBER
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3723

MAIL DATE	DELIVERY MODE
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09/07/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/692,703

Applicant(s)

KOENIG, JOSEPH M.

Examiner

Maurina Rachuba

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 9-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election-Restrictions***

1. Claims 9-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 02 October 2003.

### ***Claim Rejections - 35 USC § 102***

2. Applicant's amendment has overcome the rejection under 35 USC 102.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 5 and 6 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Kingman, 2,386,900 in view of Meyer, 5,429,545. '900 discloses the claimed invention except for the pad core being made from a flexible, compressible, polymeric foam. '545, in a similar hand held abrasive tool, teaches making the tool core from a flexible, compressible polyurethane (polymer) foam. Because both '900 and '545 teach providing a core, and bonding abrasive grit to the core to form the tool, it would have been obvious to one skilled in the art to substitute one material for the other to achieve the predictable result of a hand held tool that conforms to the shape of the workpiece.

KSR International Co. v. Teleflex Inc.; 550 U.S.---, 82 USPQ2d 1385 (2007). Further,

'900 does not explicitly disclose that the curved edge defines a radius not less than about 1/8 inch at any location on the curved edge. '900 does disclose that the edge is curved. It would have been an obvious matter of design choice to have made the curved edge of whatever size of curvature desired, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Here, '900 teaches, column 4, lines 9-18, that the curved portions of the tool may be made to fit the curved portions of the work piece. It would have been obvious to one of ordinary skill to have provided '900 with the claimed radius of curvature, dependent on the shape of the work piece being sanded.

4. Claims 3, 4, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kingman '900 in view of Meyer, 5,429,545 as applied to claim 1 above, and further in view of Hayes, 2,553,254. '900 as modified by '545 does not disclose the sharp edge defined by an acute angle in the range from about 55 to 70 degrees. '254, in a similar abrasive tool, teaches providing a sanding block conforming, when viewed macroscopically before the sanding block becomes worn, substantially to a block having two expansive sides, top and bottom **3**, and two adjacent sides, left and right, **2**, wherein a given one of the expansive sides is abrasive, wherein the given one of the expansive sides has two opposite edges, at each of which one of the adjacent sides adjoins the given one of the expansive sides. '254 does not explicitly disclose that the edges are sharp or curved, but does clearly show in the drawings that the angle between one of the expansive and adjacent surfaces is between from about 55 to 70 degrees. MPEP

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2125 states: Drawings and pictures can anticipate claims if they clearly show the structure which is claimed. In re Mraz, 455 F.2d 1069, 173 USPQ 25 (CCPA 1972).

Here, '254 clearly discloses that the acute angle (measured from a vertical line extending from the edge) formed by the expansive and adjacent sides is between about 55 to 70 degrees. If applicant argues that '254 does not disclose the claimed range, it is the examiner's position that '254 does at the least, teach that the angle between the expansive and adjacent sides be less than 90 degrees, and that the size of the angle, as long as it is less than 90 degrees, is not critical to applicant's invention, as the size of the angle would depend on the shape of the work piece being sanded. '900 discloses that the adjacent sides adjoining the expansive sides are also abrasive.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection. Applicant argues that Hays does not disclose a sharp edge when viewed macroscopically before the edge becomes worn. The examiner disagrees. As the sharpness of the edge has been defined as visually determined, and not by a defined and measurable radius of curvature, the edge as shown by Hays can be considered as a sharp edge. Applicant has defined his sharp edge as the result of an acute angle between the expansive and adjacent sides. It is noted that applicant has not disclosed a radius of curvature for the sharp edge, only that it looks sharp. By applicant's criteria, the edge disclosed by Hays is a sharp edge. Applicant should note Turgeon, et al, 6,896,606, figure 3, for a sanding block having the claimed shape.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurina Rachuba whose telephone number is 571 272 4493. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571 272 4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Rachuba/  
Primary Examiner  
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